



1743
PATENT
CYM-025
(24738-7003)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:)	Group Art Unit: 1743
)	
Ostgaard et al.)	Examiner: Patricia K. Bex
)	
Serial No. 09/156,952)	
)	
Filed: September 18, 1998)	
)	
For: SAMPLE VIAL FOR USE IN)	
PREPARING CYTOLOGICAL)	
SPECIMEN)	

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TRANSMITTAL LETTER

Mail Stop Appeal Brief Patents

Commissioner for Patents
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Alexandria, VA 22313-1450

Dear Sir:

In connection with the above-identified application, enclosed herewith for filing are the following:

- ☒ Reply Brief-CFR 1.193(b) (6 pgs.)
- ☒ Return Receipt Postcard
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July 7, 2003
Date of Deposit

Jocelyn L. Lee
Jocelyn L. Lee

Respectfully submitted,

Bingham McCutchen LLP

Dated: 7/7/03

By:



Michael J. Bolan

Reg. No. 42,339

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D. Haworth
PATENT #41
CYM-025
(24738-7003) 7/17/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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REPLY BRIEF-CFR 1.193(b)

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Alexandria, VA 22313-1450

Dear Sir:

This Brief is in reply to the Examiner's Answer dated May 5, 2003. Appellants agree with the statements made in item numbers (1)-(9) of the Examiner's Answer, and respond to the statements made in item numbers (10) and (11) of the Examiner's Answer as follows:

Appellant respectfully disagrees with the Examiner's reasoning for sustaining the rejection of claims 1-8, 10, and 12-26 as being obvious in view of the combination of Brodner and Moore.

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Jocelyn L. Lee
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A. Claimed Features are Associated with a Vial—Not Combination of Vial and Sleeve

The Examiner's interpretation of the claimed "body" to read on the combined vial 10 and sleeve 12 of Brodner bears no relationship to the plain meaning of the claim language. In construing the claims, courts first look to their language.¹ In particular, the words of the claims should be given their ordinary meaning(s) to one skilled in the relevant art in the context in which they are used, unless it clearly and unambiguously appears in the specification that the patentee intended to give the words some different meaning, or unless the patentee clearly and unambiguously surrendered such ordinary meaning(s) during prosecution.² Notably, a court may look to "extrinsic" evidence, such as dictionary definitions, to ascertain the meaning of terms and phrases used in the claims.³

In the instant case, the Examiner treats the combination of a vial and a sleeve as a single body. Based on the plain meaning of the claim language, however, a vial and associated sleeve are plainly two distinct bodies. Significantly, the preamble of claim 1 is directed to a vial, and, thus, the term "body" is a vial body. Following the Examiner's interpretation, the claimed vial comprises both a "vial body" and a "sleeve body"—a result that is contrary to the claim language. The dictionary meaning of the term "body" is "a mass

1 Inverness Medical Switzerland GmbH v. Princeton Biomeditech Corp., 309 F.3d 1365, 1371-73 (Fed. Cir. 2002); See also, Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202 (Fed. Cir. 2002) ("The terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.").

2 Rambus Inc. v. Infineon Techs. AG, 318 F.3d 1081, 1088 (Fed. Cir. 2003) ("As a general rule, claim language carries the meaning of the words in their normal usage in the field of the invention"), citing Toro Co. v. White Consol. Indus., 199 F.3d 1295, 1299 (Fed. Cir. 1999). See also, Markman, 52 F.3d at 986 (claim language means "what one of ordinary skill in the art at the time of the invention would have understood the [language] to mean.").

3 Texas Digital Systems, 308 F.3d at 1202-03 ("dictionaries, encyclopedias and treatises are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms.").

of matter distinct from other masses.”⁴ Applying this meaning to the instant case, a vial body and sleeve are distinct masses of matter, and, thus, are two separate bodies. The specification, which treats the body 12 as a distinct element from the body, is completely consistent with this “ordinary meaning” construction.

Appellant respectfully submits that it is an improper construction of the claim language to treat the combination of the vial 10 and sleeve 12 of Brodner as a single body. As such, Brodner does not disclose a body that includes the claimed anti-rotation lugs and is releasably engageable with a cap. That is, if the vial 10 of the Brodner device is taken as the claimed “body,” it can engage the cap 24, but does not have anti-rotation lugs. If the sleeve 12 of the Brodner device is taken as the claimed body, which it reasonably cannot be, since claim 1 clearly requires a vial body, it has anti-rotation lugs (as interpreted by the Examiner), but cannot engage the cap 24.

B. Lower Edge of Any “Anti-Rotation Lug” of Brodner Not Substantially Perpendicular to Outer Surface of Vial Body

As an initial matter, the Examiner indicated that the geometry of the lowermost edge of the claimed anti-rotation lug is not a relevant aspect of the invention. Appellant respectfully disagrees. The main thrust of the Examiner’s point is that Appellant never emphasized this feature in the specification—but rather relied on the figures for support. Appellant is not aware of any statute, rule, or case law that states that a feature shown in a drawing cannot be relevant to an invention unless it is emphasized in the specification. Whether it was emphasized or not in

⁴ Merriam Webster’s Collegiate Dictionary, 10th ed.

the specification, the geometry of the lower most edge of the claimed anti-rotation is a relevant aspect of the invention, as explained in Appellant's previously filed papers.

Further, Appellant believes that the Examiner has incorrectly concluded that the lowermost edges of the ridges 56 are substantially perpendicular to the outer surface of the Brodner sleeve 12. Specifically, the Examiner has concluded that the phrase "substantially perpendicular" includes a broad range of angles, because Appellant did not explicitly define what this phrase meant in the specification. In essence, the Examiner appears to transform a phantom indefiniteness rejection into a prior art rejection by interpreting the phrase "substantially perpendicular" contrary to the ordinary meaning. The claims do not stand rejected under 35 U.S.C. §112, however.⁵

In construing the phrase "substantially perpendicular," the Examiner has treated the tapered lowermost edges of ridges 56 in Brodner as "substantially perpendicular" to the outer surface of the sleeve 12. As shown in Fig. 2 of Brodner, however, the lowermost edges of the ridges 56 appear to be oriented approximately 45 degrees to the outer surface of the sleeve 12. A 45 degree orientation cannot be reasonably construed as "substantially perpendicular," as required by the claims of the present application. To find otherwise would result in the lower most edges of the ridges 56 being both "substantially perpendicular" and "substantially parallel" to the outer surface of the sleeve 12.

The Examiner concludes that Brodner does not teach that the ridges 56 of the sleeve 12 must be tapered or beveled to function properly, and, thus, can be "substantially perpendicular." The Examiner characterizes Appellant's statement to the contrary as conjecture. Appellant

⁵ Appellants note that a term of degree, such as "substantially," need not be explicitly defined in the specification for

respectfully disagrees with the Examiner's characterization. Appellant was merely applying a simple physical law to the disclosed Brodner device. That is, if the perpendicular edges of one object abuts the perpendicular edge of another object, the respective objects will not be able to slide within each other—or at the least it would be difficult for them to do so. Thus, one of ordinary skill in the art would not be motivated to make the edges of the ridges 56 in Brodner perpendicular. To do so would cause the lower most edges of the sleeve ridges 56 to abut the uppermost edges of the tray edges 68, thereby making it impossible or difficult to slide the sleeve 12 within the aperture 62 of the tray 16.

The Examiner compares the ridge 56/68 combination of Brodner with the lug 18/ramp 56 combination of the preferred embodiment of the present application. A comparison between the Brodner device and the preferred embodiment, however, only serves to support Appellant's point that there is no motivation to make the edges of the Brodner ridges 56 perpendicular.⁶ The locking type action of Brodner is bi-directional and operates on the basis that the ridges 56 of the sleeve 12 snugly fit between the ridges 68 of the tray 16 in a "pressing engagement." (See col. 3, lines 28-40). This snug fit makes it impossible—or at least difficult, to slide the sleeve 12 within the aperture 62 of the tray 16 if the edges of the ridges 56 are not tapered. In contrast, the locking type action of Brodner is uni-directional and operates on the basis that the lugs 18 react against the ramp faces 58 to prevent rotation of the vial body 12. The lugs 18 are not designed to snugly fit between the ramps 56 of the interface 54.

it to be definite. Section 2173.05(b) of the M.P.E.P. provides that if one of ordinary skill in the art would nevertheless be reasonably apprised of the scope of the invention, a term of degree is definite.

⁶ Appellant adds that such a comparison is not relevant in any event. The question is whether one of ordinary skill in the art would be motivated to modify the Brodner sleeve 12 by making the edges of the ridges 56 perpendicular—not whether the ridges 56 of the Brodner sleeve 12 function in a similar manner as the lugs 18 of the preferred embodiment.

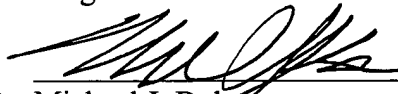
For the above reasons, Appellant believes that the Examiner's rejections of claims 1-8,
10, and 12-26 should be overturned.

Respectfully submitted,

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Dated: 7/7/03

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